

## **REMARKS**

### ***Status of the claims***

Upon entry of these remarks, claims 1, 16-32, 48, 63, 78, 103, 121 and 139 will be pending in this application. Claims 2-15, 33-47, 47-62, 64-77, 79-102, 104-120, and 122-138 have been cancelled. Applicants reserve the right to pursue the subject matter of the cancelled claims in one or more divisional applications.

### ***Amendments to the claims***

Claims 16, 32, 48, 63, 78, 103 and 120 have been amended to delete an erroneously appended claim. Additionally claims 25 and 26 have been amended to correct the misspelling of the word, "heterologous". New claim 139 has been added. Support for this claim may be found in the specification as filed, for example, in paragraph [0069] and in Example 1. No new matter has been added by way of amendment. Applicants respectfully request these amendments be entered.

### ***Provisional Election***

Pursuant to the Restriction Requirement dated April 23, 2004, the Examiner has required an election under 35 U.S.C. § 121 of one of the following groups:

Group I, represented by claims 1-15, drawn to a method of stimulating phosphate absorption by a cell;

Group II, represented by claims 16-31 and newly added claim 139, drawn to a method of increasing resistance of a cell to hypoxic stress;

Group III, represented by claims 32-47, drawn to protecting a cell [challenged] by hypoxic stress;

Group IV, represented by claims 48-62, drawn to a method of protecting a cell against harmful calcium levels;

Group V, represented by claims 63-77, drawn to a method of protecting a cell against calcium-mediated cell death;

Group VI, represented by claims 78-102, drawn to a method of diagnosing neural injury;

Group VII, represented by claims 103-120, drawn to a method of protecting a patient against neural injury;

Group VIII, represented by claims 121-138, drawn to a method of treating a patient having neural injury.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the subject matter of Group II, represented by claims 16-31 and newly added claim 139. Applicants submit that the subject matter of new claim 139 is fully supported by the specification as filed and falls within the scope of Group II as defined by the Examiner. Applicants reserve the right to file one or more divisional applications directed to the non-elected groups.

Applicants respectfully traverse the restriction requirement into Groups I-VIII. As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a “serious burden.” See M.P.E.P. § 803. Applicants submit that a search of the elected group of claims directed to a method increasing resistance of a cell to hypoxic stress by contacting said cell with a stanniocalcin polypeptide cannot be performed without searching the stanniocalcin polypeptide itself. The search of the stanniocalcin polypeptide would clearly provide useful information for the remaining groups. For example, the search for publications which disclose the stanniocalcin polypeptides would lead the Examiner to references which disclose not only the polypeptides, but also methods of using or detecting the stanniocalcin polypeptides which would be relevant to evaluation of the claims of Groups I and III-VIII. Applicants submit that it would not be a serious burden to examine all the claims of Groups I-VII together.

Applicants respectfully request that the present restriction requirement be withdrawn upon consideration of the above arguments and in view of M.P.E.P. § 803.

## CONCLUSION

In view of the foregoing remarks, Applicants believe that this application is now in condition for substantive examination. The Examiner is invited to call the undersigned at the phone number provided below if any further action by applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

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